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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,895	11/30/2001	David Samuel Cohen	111465.127	4229

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EXAMINER

SIEFKE, SAMUEL P

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,895

Applicant(s)

COHEN, DAVID SAMUEL

Examiner

Samuel P Siefke

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11,12,14-27 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-12,14-27,30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **11,12,14-27, 30-35** are rejected under 35 U.S.C. 102(e) as being anticipate by Kellogg et al. (USPN 6,063,589).

Kellogg discloses a method and apparatus for performing microanalytic analyses on a platform by rotation, thereby utilizing the centripetal forces resulting from rotation of the platform to motivate fluid movement through microchannels embedded in the microplatform. Kellogg discloses an optical bio-disc that comprises a substrate (col. 8, lines 6-38) having encoded information being readable by a disc drive assembly to control rotation of the disc (col. 8, line 37-col. 9, line 20); an antechamber (fig 6a-k; entry port 301); a separation chamber in fluid communication with the antechamber (302; metering capillary allow extra sample to over flow, which separates the sample volume); a metering chamber in fluid communication with the separation tube (303; fluid chamber is connect to the metering chamber and also is provided with a overflow line 304 for metering); an assay zone in fluid communication with the metering chamber so that when a sample is deposited in the antechamber and a rotation is applied, a metered

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amount of a liquid component is moved to the assay zone (col. 17, lines 5-21). The assay chamber includes optical detection of the reaction that occurs in the assay (col. 14, lines 6-35; col. 17, lines 5-21). With regards to claim 14, a disk drive is not claimed, and is not attributed patentable weight, even though Kellogg teaches a read head (col. 14, lines 6-34; col. 9, lines 16-20). Throughout Kellogg there are multiple embodiment which cover all the limitations of claimed subject matter in the instant application. The above embodiment further comprises a waste chamber (306) that is in fluid communication with both the metering chamber (fig. 6a-k). With respect to claims 16-27 and 30-35, it is noted that Applicant recites limitation on the manner in which the biodisk is used. Such limitations are not attributed patentable weight in claims to the device. It is also noted that Kellogg teaches a process in which incorporates the steps recited in these claims. Kellogg discloses that samples to be used in this apparatus comprise blood, plasma, serum, lymph, saliva, tears, cerebrospinal fluid, urine, sweat, plant and vegetable extracts, semen and ascites fluid and does not limit just to these specific examples (col. 6, lines 1-6). Kellogg also discloses a process of using an optical biodisc for separating, metering and analyzing a biological sample (col. 12, line 1 –col. 14, line 38). Kellogg imparts a first rotation to the disc whereby the fluid flows into the metering chamber while excess fluid flows to overflow chamber, a second rotation is imparted on the disc where the fluid in the metering chambers flows to the fluid chamber. Then analysis of the components in the sample are analyzed (col. 14, lines 6-34).

### ***Response to Arguments***

Applicant's arguments filed 10/18/04 have been fully considered but they are not persuasive. Applicant argues, "this is the only reference to anything that may in some way relate to Applicant's encoded information." The Office would like to point to col. 8, lines 41-44, where in Kellogg's discloses "The optical pits provided means for encoding instrument control programming, user interface information, graphics and sound specific to the application and driver configuration." Then further goes on to define each of these further wherein, the rotation programs are then discussed. Clearly this meets the limitations of the current application. Applicant argues, "Applicant has also been unable to identify any further information clarifying what an "instrument" would be, and thus what "instrument control programming" would entail." Since the word "instrument" is so broad as defined by Webster's Ninth New Collegiate Dictionary "a measuring device for determining the present value of a quantity under observation" it applies to any measuring device as defined above. In this case a sample is measured and a quantified. Applicant argues, "there is neither any teaching nor any suggestion in Kellogg of a "substrate having encoded information associated therewith, the encoded information being located on the bio-disc and configured so as to be readable by a disc drive assembly to control rotation of the disc." As discussed above in col. 8, lines 41-44, where in Kellogg's discloses, "The optical pits provided means for encoding instrument control programming, user interface information, graphics and sound specific to the application and driver configuration." It is inherent that there is a means to read

the encoded information on the substrate because Kellogg discusses the disc can be compact discs, and it is known in the art that compact discs are read by a disc drive assembly.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke



January 7, 2005



Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700